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Orlando W. Stephenson III

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ORLANDO W. STEPHENSON III, KIM D. McCOMB, DAVE J.
LOOKS, and LEE M. TERPSTRA

Appeal 2009-002497
Application 10/810,911
Technology Center 3700

Decided:¹ August 3, 2009

Before TONI R. SCHEINER, ERIC GRIMES, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a gaming machine having a door with a horizontal cross member that can be adjusted

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

to different vertical positions. The Examiner has rejected the claims as obvious in view of the prior art. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

The Specification states that gaming machines typically have a cabinet and a front door that “typically includes a relatively large opening with one or more screens covering the opening and facing the user” (Spec. 1, ¶ 2). “Existing game machines may utilize a crossbar that extends across the opening to form upper and lower openings in the door, each opening providing viewing access to a video display or reel device. However, known crossbars are typically an integral portion of the door.” (*Id.*)

The Specification discloses a gaming machine having a door with an enlarged opening and a horizontal cross member extending across the opening: “The cross member is adjustably secured to the door such that the vertical position of the cross member can be adjusted to vary the size of an upper portion of the enlarged opening above the cross member, and a lower portion of the enlarged opening below the cross member.” (*Id.* at 1-2, ¶ 3.) The Specification discloses that the adjustable crossbar “permits the gaming machine to be readily configured to provide for a large number of different sizes and combinations of display screens and/or reel devices” and “permits the gaming machine to be reconfigured/retrofitted in the event the requirements concerning the size and/or types of video displays and/or reel devices changes” (*id.* at 5-6, ¶ 18).

Claims 1-25 are pending and on appeal. Claim 1 is representative and reads as follows:

1. A gaming machine, comprising:
 - a cabinet defining an internal space and a front side, the cabinet having an opening in the front side for providing access to the internal space;
 - a door movably mounted to the cabinet for movement between an open position providing access to the internal space, and a closed position wherein the door substantially closes off the opening in the cabinet, the door having an enlarged opening defining generally vertical spaced apart side edges;
 - at least one sheet mounted to the door and extending across at least a substantial portion of the opening in the door, the sheet having an outside surface, at least a portion of the sheet being see-through; and
 - a generally horizontal cross member extending across the enlarged opening and having opposite ends positioned adjacent the vertical side edges when in any one of a plurality of vertically-adjusted positions, the cross member including fasteners removably securing the cross member to the door in a selected one of the vertically-adjusted positions, such that the vertical position of the cross member can be adjusted during installation to vary the size of an upper portion of the enlarged opening above the cross member, and a lower portion of the enlarged opening below the cross member.

OBVIOUSNESS

Issue

The Examiner has rejected claims 1-25 under 35 U.S.C. § 103(a) as obvious in view of Cole² and Engلمان³ (Answer 3). The Examiner finds that Cole discloses a gaming machine having a door with an enlarged opening and a sheet across the opening but “lacks disclosing a cross member across the opening” (*id.*). The Examiner finds that “Engلمان discloses a gaming system with two video displays with a dividing cross member” (*id.*)

² Cole, US 6,475,087 B1 issued Nov. 5, 2002.

³ Engلمان, US 2003/0157978 A1 issued Aug. 21, 2003.

and concludes that it would have been obvious to modify Cole's apparatus to include "a second display with a separating cross member" (*id.* at 4).

The Examiner acknowledges that the references, even if combined, do not disclose a vertically adjustable cross member (*id.*). The Examiner reasons, however, that there are only so many ways of attaching a cross member to the door of a gaming machine, and that

[a]s Cole already teaches that it is desirable to have a display sheet or mount that is replaceable and removable in order to ease the modification of a gaming machine, it would have been obvious to one skilled in the art at the time that providing removable attachment cross members would be desirable and with only two places to choose from [i.e., the door itself and the sheet across the opening] it would be obvious to try attaching the cross member to the display sheet or mount.

(*Id.*)

Appellants contend that "neither cited art of Cole '087 and/or Englman '978 show or suggest a vertically-adjustable cross member, nor even a reason to modify the existing art to make one" (Appeal Br. 17). Appellants also contend that they have presented declaratory evidence to support their position that the claimed product would not have been obvious to those of ordinary skill in the art (*id.* at 15-16, 18).

The issue presented is: Does the evidence of record support the Examiner's position that a person of ordinary skill would have considered it obvious, based on Cole and Englman, to modify Cole's machine to include an adjustable cross member?

Findings of Fact

1. Cole discloses a “gaming apparatus compris[ing] a cabinet and a door. . . . The door has an opening therein. At least one mount is provided for mounting a member to the door for viewing through the door opening.” (Cole, col. 2, ll. 16-23.)

2. Cole discloses that a reel-screening panel can be mounted to the door “when a reel mechanism is mounted to the cabinet . . . , whereby the reels are viewable through the reel-screening glass when the door is in its closed position” (*id.* at col. 2, ll. 24-29).

3. Cole discloses that, alternatively, a video display can be mounted to the door so that the video display is viewable through the opening (*id.* at col. 2, ll. 29-31).

4. Cole discloses that “the ‘base’ configuration of the gaming device of the invention, no matter what game is presented, is the same. As arranged, the window 66 placement and arrangement of the cabinet 22 is such that either the display 190 or a panel 68/reel mechanism 50 combination may be used therewith” (*id.* at col. 9, ll. 16-21).

5. Cole discloses that the base configuration of the game can be switched between presenting a reel-type slot game and a video-type game (*id.* at col. 2, ll. 44-54).

6. Cole discloses that,

[f]or example, a particular casino may first obtain the device configured as a slot type machine. Based on consumer demand, the casino may find it desirable to offer a greater number of video type gaming devices. In such an event, the gaming device in accordance with the invention can readily be configured by removing the reels, controller and glass, and

replacing them with an LCD display and appropriate video game control.

(*Id.* at col. 9, ll. 29-36.)

7. The Examiner has not pointed to any disclosure in Cole of a need for, or advantage to, including a cross member in the viewing window of its machine.

8. Englman discloses a gaming machine having two displays separated by a horizontal cross member (Englman, Figure 1).

9. Englman discloses that the gaming machine is “operable to conduct a game of chance including a basic game and one or more bonus games triggered by respective special outcomes in the basic game” (*id.* at 2, ¶ 24).

10. Englman discloses that the “gaming machine 10 includes a primary display 12 and an optional secondary display 13 generally above the primary display 12. The primary display 12 is primarily associated with the basic game, while the secondary display 13 is primarily associated with the bonus games.” (*Id.* at 2, ¶ 25.)

11. The Examiner has not pointed to any disclosure in Englman of a need for, or advantage to, changing the respective size of the windows in its machine.

12. Appellants have submitted a declaration under 37 C.F.R. § 1.132 of Jason Sprinkle (filed Dec. 5, 2007).

13. Mr. Sprinkle declares that he is Director of Operations for a company that makes, buys, and sells gaming machines and is “intimately aware of gaming cabinets available in the industry” (Sprinkle Declaration, ¶¶ 1, 3).

14. Mr. Sprinkle declares that the “doors of gaming cabinets traditionally have been built like vault doors, with heavy, solid, and integrally-connected, permanently-secured door frame members and cross members” (*id.* at ¶ 9).

15. Mr. Sprinkle declares that changing the games played on “[g]aming cabinets built like ‘vaults’” is expensive and requires long delivery times (*id.* at ¶ 10).

16. Mr. Sprinkle declares that despite the disadvantages of existing game doors, he was “not aware of anyone addressing this need in the manner stated in the claims of this patent application prior to its filing date” (*id.* at ¶ 10).

Principles of Law

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.” *Id.*

An invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

“[I]nterrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all [should be considered] in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed.” *Id.*

Analysis

Neither Cole nor Englman discloses a gaming machine having a door with an adjustable cross member. Neither Cole nor Englman discloses a need for, or an advantage of, an adjustable cross member in the door of a gaming machine. Appellants have provided declaratory evidence from a person skilled in the art who declared that he was not aware of gaming machines including a door with an adjustable cross member despite the recognized disadvantages of known gaming machine doors.

The Examiner concludes, however, that the claimed device would have been obvious because gaming machines with doors having nonadjustable cross members were known, and those skilled in the art would have recognized that a cross member attached removably to a door would have been an alternative to a fixed cross member (Answer 4).

We agree with Appellants that the Examiner’s reasoning relies on impermissible hindsight. It may be true that those skilled in the art would have recognized that a cross member could be attached to a gaming machine door in an adjustable way, and would have considered doing so obvious, after the present applicants described the advantages of an adjustable cross member.

However, in relying upon *KSR*, the Examiner mixes two different types of evidence necessary for a prima facie case of obviousness. The first type of evidence is the demonstration that each of the elements was known in the prior art. The second type of evidence is that there was a reason to combine the elements as shown in the claimed invention.

It is the first type of evidence which is lacking in this rejection. There is no evidence which discloses the claimed element of an adjustable cross member in any context, whether a gaming machine or other device (FF 7-11). *KSR* focuses on determining “whether there was an apparent reason to combine the known elements.” *KSR*, 550 U.S. at 418. The foundation of the analysis begins with determining if the elements were “known,” prior to determining whether there was a reason to combine. Here, the Examiner has provided no evidence or logical reasoning that supports a conclusion that putting an adjustable cross member on a gaming machine door would have been obvious based on the prior art and what was known to a person of ordinary skill in the art at the time this application was filed.

Cole and Engلمان provide no evidence that a gaming machine with an adjustable cross member was known or would have been obvious, and Mr. Sprinkle has testified that he was not aware of others in the field addressing the known disadvantages of prior art gaming machine doors in the manner claimed. Without evidence that an adjustable cross member was known in the prior art, the analysis does not reach the question of whether there is a reason to combine this element with the remaining prior art. We conclude that the Examiner’s rejection is not supported by a preponderance of the evidence of record.

Conclusion of Law

The Examiner's position that a person of ordinary skill would have considered it obvious, based on Cole and Englman, to modify Cole's machine to include an adjustable cross member is not supported by preponderance of the evidence of record.

SUMMARY

All of the claims on appeal require a vertically adjustable cross member. For the reasons discussed above, we reverse the rejection of claims 1-25 as obvious in view of Cole and Englman.

REVERSED

cdc

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